



PATENT
P56525RE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re Application of:

Appeal No. _____

KI-OOK PARK *et al.*

Original Patent No. 5,917,679 issued on 29 June 1999

Serial No.: 09/892,790

Examiner: TUPPER, ROBERT S.

Filed: 28 June 2001

Art Unit: 2652

For: PSEUDO CONTACT TYPE NEGATIVE
PRESSURE AIR BEARING SLIDER

RECEIVED

DEC 11 2002

Technology Center 2600

Attn: Board of Patent Appeals & Interferences

APPEAL BRIEF

Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to Appellant's Notice of Appeal filed on the 9th of December 2002, Appellant hereby appeals to the Board of Patent Appeals and Interferences from the final rejection of claims 21 through 60, as set forth in the Advisory Action mailed on 9 July 2002 (Paper No. 9).

Folio: P56525RE
Date: 12/9/02
I.D.: REB/wc

I. REAL PARTY IN INTEREST

Pursuant to 37 CFR §1.192(c)(1)(as amended), the real party in interest is:

SamSung Electronics Co., Ltd.
#416, Maetan-dong, Paldal-gu
Suwon-city, Kyungki-do, Republic of KOREA

as evidenced by the Assignment recorded in the United States Patent & Trademark Office on the 6th day of March 1998 at Reel 9030, frame 0967.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and no interferences known to Appellant, Appellant's legal representatives or the assignee which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 through 60 are pending in this application. Claims 1 through 20 have been allowed. Claims 21 through 60 stand finally rejected as stated in the final Office Action (Paper No. 9). Of the latter claims, claims 21, 31, 42, 52, 55 and 58 are independent, whereas the remaining claims are dependent.

IV. STATUS OF AMENDMENTS

Two Amendments were filed after the final Office action (Paper No. 9) mailed on 9 July 2002, amending claims 16, 21, and 31. The first amendment under 37 CFR §1.116(b) was filed on

the 9th of October 2002. In Paper No. 12, an Advisory Action dated on the 16th of October 2002, the Examiner stated that the proposed amendment would not be entered.

A second amendment under 37 CFR §1.116(b) was filed on the 27th of November 2002. In Paper No. 15 dated on the 5th of December 2002, the Examiner refused entry of the second amendment.

A third amendment under 37 CFR §1.116(b) was filed simultaneously with this Appeal Brief on the 9th of December 2002 to proposed only amendment of claim 16 in one instance. As of the filing date of this Appeal Brief, the Examiner has not yet considered the second amendment.

V. SUMMARY OF INVENTION

Turning to Figs. 4 and 5, the pending claims define Applicant's negative pressure slider for a hard disk drive with trailing air bearing surface platforms 110c and 110d symmetrically disposed on opposite sides on a longitudinal axis of the slider body 100 and aligned with one another in a lateral direction of the slider body 100, to provide a positive lifting force at the air outlet between the slider body 100 and the disc surface (not shown). Column 5, lines 25-32. As is explained in applicant's patent,

“ these trailing ABS platforms 110c and 110d ... provide a positive lifting force at an air outlet between the slider body and the disc surface (not shown).” Column 5, lines 27-33.

An arcuate cross rail 130 extends across the principal surface 111 of the slider 100 between air bearing surface platforms 110c, 110d. Column 5, lines 37-41.

As explained in the original specification,

“[t]he arcuate cross rail 130 and the rear ABS platforms 110c and 110d together define a substantially U-shaped projection that extends from the principal surface 111 of the slider 110. The curvature of the cross rail 130 forms a negative pressure cavity 150, that may be somewhat rounded at the center of the slider body 110.” Column 5, lines 41-46.

The negative pressure cavity 150 functions to provide a downward pulling action on the slider body 100, which in turn creates a gram load equivalent effect that enhances stability. Column 6, lines 4-7.

Another advantage of the arcuate configuration of the cross rail 130 resides in the fact that contaminants will have less of tendency to accumulate against the front wall of the cross rail. Column 6, lines 19-22. That is, contaminants will instead tend to travel along the arcuate front wall and exit off the side of the slider body between the gaps formed by the front corner ABS projections. Column 6, lines 22-25. This also enhances read/write performance of the slider 100 over the long-run. Column 6, lines 25-26.

VI. ISSUES

I. Rejection of Claims 21 Through 60 Under 35 U.S.C. §251

A. Does 35 U.S.C. §251 Prohibit The Allowance Of Reissue Claims That Are Broader In Scope Than The Patented Claims?

B. Does 35 U.S.C. §251 Require That Reissue Claims Which Are Broader In Scope Than The Patented Claims Contain All Of The Constituent Elements Of The Narrowest One of Those Patented Claims?

C. Does 35 U.S.C. §251 Prohibit Allowance Of Reissue Claims That Are Patentably Distinguishable Over The Prior Art For Reasons That Are Different From The Reasons For Allowance Of The Patented Claims?

D. Did The Examiner Correctly Follow The Procedure Established By The Commissioner Of The United States Patent & Trademark Office For Making A Determination Of An Improper Recapture Under 35 U.S.C. §251?

E. Where Appellant Correctly Demonstrated That The Prior Art Fails To Teach What An Office Action Represented That Art As Allegedly Teaching, Does Appellant's Demonstration Of Those Omissions In The Art Thereafter Create A Recapture Estoppel That Restricts The Scope Of Reissue Coverage To Only Reissue Claims That Recite Each And Every Item That Was Found Lacking In The Prior Art's Teaching?

F. May A Recapture Rejection Under 35 U.S.C. §251 Be Maintained Where The Office Action Fails To Make A Finding Of Which Aspects Of The Reissue Claims Are Broader Than The Patented Claims, And Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter?

G. Is This Particular Recapture Rejection of Claims 21-60 Under 35 U.S.C. §251 An Improper, Back-door Attempt To Revive The *Point-of-novelty* Criterion For Patentability?

H. Do Alternative Statements Made By An Appellant To Explain The Impropriety Of A Rejection Under 35 U.S.C. §102 Constitute An Amendment Of The Rejected Claim Or Constitute A Surrender Of Patentable Subject Matter Under 35 U.S.C. §251?

I. Even Ignoring Arguendo A Lack Of Basis For Imposition Of A Rejection Under 35 U.S.C. §251 And The Doctrine Of Recapture, And A Failure Of The Examiner To Follow The Mandated Procedure Under *MPEP* §1412.02, Do Claims 21 Through 60 Each Define At Least One Of The Constituent Aspects Required By The Examiner To Avoid Recapture?

II. Rejection of Claims 21 through 41 Under Second Paragraph of 35 U.S.C. §112

A. Is A Rejection Under The Second Paragraph of 35 U.S.C. §112 For Failure *to recite any reference to the locations of the listed features* Improper Where The Applicant Defines Five (5) Structural Features Of Claim 21 By Defining The Location Relative To The Orientation Of The Air Bearing Slider Claimed?

B. Is A Rejection Under The Second Paragraph of 35 U.S.C. §112 On Grounds That

Claim 31 *fails to recite a reference for 'the first direction'* Improper Where The Applicant Uses The "first direction" To Establish Structural Relationships Between Three (3) Constituent Elements Of Claim 31?

III. Rejection of Claims 21 through 60 Under First & Second Paragraphs of 35 U.S.C. §112

A. Where The Rejected Claims Define An Embodiment Of The Appellant's Invention As Disclosed In Appellant's Original Patent, Can There Be Proper Basis For Maintaining A Rejection Under The First Paragraph Of 35 U.S.C. §112 For Failure To Provide Either A Written Description Of The Invention Or For Failure To Provide Enablement?

B. Where No Error Or Other Instance Of Inaccuracy Or Indefiniteness Is Averred In An Office Action, Can A Rejection Under The Second Paragraph Of 35 U.S.C. §112 Be Proper?

IV. Rejection Of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela '981

A. Where The Applied Art Fails To Disclose All Of The Elements Of The Rejected Claims, Can There Be An Anticipation Under 35 U.S.C. §102(a)?

VII. GROUPING OF THE CLAIMS

Normally, these appeals may be briefed, argued and decided with one or two representative claims. Here, numerous issues are presented in the first Office action and repeated in the final Office action, sometimes with direct application to particular claims while ignoring others of the rejected claims, and in other instances to several or all of the reissue claims *en mass* without explanation of the application of the rejection to recognition of the distinctions and differentiations existing

between the rejected claims. The claims do not therefore, stand or fall together, and thus the claims are grouped as individually, for the reasons set forth in the following arguments.

A. Rejection of Claims 21 Through 60 Under 35 U.S.C. §251

In the Examiner's comments accompanying the rejection of claims 21 through 60 under 35 U.S.C. §251, the Examiner differentiated between independent reissue claims 21, 31, 42, 52, 55 and 58; consequently these claims must be grouped independently of one another.

B. Rejection of Claims 21 through 41 Under Second Paragraph of 35 U.S.C. §112

The Examiner separately addressed independent claims 21 and 31 in explaining the rejection of claims 21 through 41 under the second paragraph of 35 U.S.C. §112; accordingly, these claims are grouped separately from one another.

C. Rejection of Claims 21 through 60 Under First & Second Paragraphs of 35 U.S.C. §112

Claims 21 through 60 differ from one another in their definitions. The Final Office action did not address these distinctions. Moreover, the final Office action did not allege any error under either the first or the second paragraphs of 35 U.S.C. §112 in any particular, by the language of any of claims 21 through 60. Consequently, and in view of the differences in language between these claims, they are grouped separately from one another.

D. Rejection Of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela '981

Claims 21, 30 through 32 and 41 differ in language and scope from one another. The final Office action did not apply Nepela '891 to any of these claims. Each of these claims is grouped separately in consideration of the rejection of these claims under 35 U.S.C. §102(a) as anticipated by Nepala'981.

VIII. ARGUMENT

I. Rejection of Claims 21 Through 60 Under 35 U.S.C. §251

In paragraph 2 of the Office action, the Examiner rejected claims 21 through 51 under 35 U.S.C. §251 “as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.” Appellant respectfully traverses this rejection for at least the following reasons.

A. 35 U.S.C. §251 Allows Reissue Claims That Are Broader in Scope Than The Patented Claims.

Nothing in 35 U.S.C. §251 either defines “recapture” or prohibits “recapture”. §251 does however, expressly provides for *broadening* of the scope of the claims of the original patent. Appellant is within the express grant of entitlement to seek broadened claims in this reissue application. In support of this rejection, the Examiner cited *Hester Industries, Inc. v. Stein, Inc.*, 46 USPQ2d 1441 (Fed. Cir. 1998); *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997) and *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984). During the office interview, the Examiner stated that he was not familiar with these judicial decisions, and had not read these decisions, and explained that the citation of these three decisions was simply part of the form paragraph used in the

rejection.

Appellant invites the Board's attention to the reasoning of the Court of Appeal for the Federal Circuit and to the Court's consistent repudiation of the Examiner's rationale.

By way of example, in *Ball Corp.*, the Court of Appeals for the Federal Circuit rejected the Government's assertion of the existence of a recapture type of estoppel, where the Appellant filed a reissue application within the two-year period for broadened reissue. The Court ruled that the doctrine of recapture "will not bar *Ball* from securing the reissued claims here on appeal" where the reissue claims were "broader than the claims of the original patent" in defining the geometric configuration of the antenna in the original patent application. Although the Court of Appeals found that the claims cancelled in the original application were "limited to an antenna of cylindrical [antenna] configuration, whereas the reissued claims were not so limited," the Court spurned the government's assertion that recapture occurred because the reissued claims were not also limited to a cylindrical antenna configuration, and held that the Appellant was entitled to obtain reissued claims that covered antennas that did not have a cylindrical configuration. To reach this holding, the Court dismissed the government's theory that an applicant's failure to obtain broader claims during examination of the parent creates an estoppel that bars the applicant from obtaining valid reissue claims that omit limitations (*e.g.*, the cylindrical antenna geometry) that were present in the claims during the examination of the parent patent.

That holding is applicable here, where the Examiner seeks to reject Appellant's claims in a situation very similar to *Ball*, by imposing a theory of recapture estoppel to support rejections of reissue claims for failure to include such limitations as "first and second projections defining "first

and second air bearing surfaces”; “arcuate front wall portion” and “third and fourth air bearing surfaces” as were set forth in Appellant’s original claims 1 through 10 and 14, which were initially rejected in Paper No. 4 in parent application Serial No. 08/915,342 as “being clearly anticipated by Chapin *et al.* (5,200,868)” and subsequently allowed over Chapin ‘868. The fallacy in the Examiner’s rejection lies in the fact that these limitations were already present in rejected claims 1 through 10, and were not added in an amendment to overcome the anticipation rejection. Moreover, Appellant amended independent claim 1 to broaden the scope of coverage by, for example, changing the phrase “curved front wall portion” to the broader phrase “arcuate front wall”; and making a wholesale deletion of the clause “curved front wall portion and said first and second curved wall portions being spaced apart from said first and second projections, wherein the first and second curved sidewall portions respectively extend along said first and second side portions of said principal surface”. Appellant also made other broadening amendments in claim 1. In response to Appellant’s demonstration in the *Remarks* of Paper No. 6, of the absence of anticipation, the Examiner withdrew the rejection under 35 U.S.C. §102(b), and allowed the broadened amended claim 1, together with claims 2 through 10 and 14. No basis for “recapture” occurred. Accordingly, this rejection can not be maintained.

B. 35 U.S.C. §251 Does Not Require That Reissue Claims Which Are Broader in Scope Than The Patented Claims Contain All Of The Constituent Elements Of The Narrowest One of Those Patented Claims.

In support of this rejection, the Examiner reasons that:

The following limitations have been omitted from the newly presented reissue claims: “first and second projections” defining “first and second air bearing surfaces” (claims 21, 31, 42, 52, 55 and 58); “arcuate front wall portion” (claims 21, 31, as now amended 42, 52, 55, and 58), and “third and fourth air bearing surfaces” (claims 21, 52, 55, and 58).

In the amendment of 12/01/98 in the parent application Appellant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces.”

Appellant respectfully invites the Examiner’s attention to the language of 35 U.S.C. §251, which expressly contemplates the right of an Appellant to be granted a:

“reissued patent ... *enlarging the scope* of the claims of the original patent” 35 U.S.C. §251 (emphasis added).

The Examiner’s reasoning seeks to incorrectly place a restriction upon the Appellant’s right, by asserting that 35 U.S.C. §251 *sub silentio*, creates an estoppel that requires that claims that enlarge the scope of the claims of the original patent be allowable for the identical reasons argued by an Appellant in support of the allowability of the original claims. This is not the law under 35 U.S.C. §251. Accordingly, this rejection can not be maintained.

C. 35 U.S.C. §251 Does Not Prohibit Allowance Of Reissue Claims That Are Patentably Distinguishable Over The Prior Art For Reasons Different From The Reasons For The Allowability Of The Patented Claims.

Another flaw in this rejection of reissue claims 21 through 60 is that the Examiner’s expressed rationale is wholly unsupported by either statute, rule of the Commissioner, or judicial

interpretation of the statute. When the Examiner asserts that:

“[t]he following limitations have been omitted from the newly presented reissue claims: “first and second projections” defining “first and second air bearing surfaces” amended 42, 52, 55, 58), and “third and fourth air bearing surfaces” (claims 21, 52, 55, and 58).”

the Examiner ignores the absence in 35 U.S.C. §251 of any language that prohibits the allowance of reissue claims that are patentably distinguishable over the prior art for reasons that are different from those reasons that distinguish the patented claims from the prior art. When the Examiner states that,

“[I]n the amendment of 12/01/98 in the parent application Appellant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces”,

the Examiner is improperly endeavoring to limit a reissue Appellant to only those reissue claims that are patentably distinguishable over the prior art for the very same reasons as the patented claims. This necessarily limits the Appellant to the presentation of reissue claims that are coincidental in breath and scope to the patented claims; such reissue claims would be essentially duplicates of the patented claims. The Examiner’s endeavor ignores the express grant by 35 U.S.C. §251 of the patentee’s right to obtain broader claims within a two year period after the issue of the patented claims. In short, the Examiner has no grant of authority under 35 U.S.C. §251 to reject claims of enlarging scope that are allowable for reasons not enunciated by an Appellant during the examination of the original patent either in the *Remarks* or in an *Appeal Brief*, or by the Board in a *Decision on an Appeal*. The Examiner’s statement that claims 21 through 60 are unpatentable under 35 U.S.C.

§251 because:

“[t]he following limitations have been omitted from the newly presented reissue claims: “first and second projections” defining “first and second air bearing surfaces” (claims 21, 31, 42, 52, 55, and 58); “arcuate front wall portion” (claims 21, 31, as now amended 42, 52, 55, and 58), and “third and fourth air bearing surfaces” (claims 21, 52, 55, and 58).”

is specious. Accordingly, there is no lawful basis for maintaining a rejection of reissue claims of enlarging scope, even if those claims are allowable for reasons other than those either argued by the Appellant or stated by the Board of Appeals, during prosecution of the original patent. Reversal of this rejection of claims 21 through 60 is therefore requested.

D. A Rejection Alleging Improper Recapture Under 35 U.S.C. §251 Must Follow The Procedures Established By The Commissioner of the United States Patent & Trademark Office.

A second flaw in the Examiner’s reasoning lies in the Examiner’s failure to recognize that nothing was surrendered during prosecution of the parent application. The Office action has alleged recapture without following the procedure mandated by the Commissioner. Application of the doctrine of recapture requires that the Examiner follow well defined procedural steps. Judicial interpretations of 35 U.S.C. §251 such as that set forth in *Pannu v. Storz Instruments Inc.*, 59 USPQ2d @ 1600 (Fed. Cir. 2001) earlier cited by the Examiner, details the three-step process for application of the recapture rule. The first step is to:

“determine whether and in what aspect the reissue claims are broader than the patent claims,”

and the second step,

“is to determine whether the broader aspects of the reissued claim relate to surrendered subject matter.”

As explained in §1412.02 of the *Manual of Patent Examining Procedure* (8th edition) (August 2001)),

“The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims.” *MPEP* §1412.02.

“The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter.” *MPEP* §1412.02.

The *Manual* instructs the Examiner that, in order:

“To determine whether an Appellant surrendered particular subject matter, we look at the prosecution history for arguments and changes to the claims made *in an effort to overcome* a prior art rejection.” *MPEP* §1412.02.

The practice outlined by the *Manual* is mandatory.

This rejection action is incomplete under 37 CFR §1.104(b) and (c) because the action not only fails to identify “in what **aspect** the reissue claims are broader than the patented claims” (that is, to make the first step required by *MPEP* §1412.02), but more significantly, fails “to determine whether the broader aspects of the reissued claims relate to surrendered subject matter” (the second step set forth in *MPEP* §1412.02). When the Examiner writes that:

“[t]he following limitations have been omitted from the newly presented reissue claims: “first and second projections” defining “first and second air bearing surfaces” amended 42, 52, 55, 58), and “third and fourth air bearing surfaces” (claims 21, 52, 55, and 58).”

and that:

“[I]n the amendment of 12/01/98 in the parent application Appellant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces”,

the Examiner is not complying with the first step of the mandatory procedural requirement of *MPEP* §1412.02) (to “determine whether and in what aspect the reissue claims are broader than the patent claims,”) because several of these features are present in both the patent claims as well as in the reissue claims. In short, this Office action has failed to determine in what aspect the reissue claims are broader than the patent claims as is required by the first step of *MPEP* §1412.02.

Moreover, the foregoing statements by the Examiner fail to comply with the second procedural step of *MPEP* §1412.02 by identifying any surrendered subject matter among those aspects that make the reissue claims broader than the patent claims. The Examiner’s listing of three constituent elements of Appellant’s original claim 1, some of which were amended to more broadly define those elements in the parent’s prosecution, is not the identification of surrendered subject matter required by *MPEP* §1412.02. As was discussed in Appellant’s response of the 9th of October 2002, the failure of the Office action to identify surrendered subject matter is directly attributable to the fact that careful examination of the prosecution history establishes an absence of any evidence of record of the occurrence of a surrender of any subject matter during prosecution of the parent application.

Turning now to a review of the amendments made by the Appellant during the prosecution of the original patent, §1412.02 of the *Manual of Patent Examining Procedure* (8th edition) (August 2001)) instructs the Examiner, that:

“[t]o determine *whether* an Appellant surrendered particular subject matter, we look at the prosecution history for *arguments and changes* to the claims made *in an effort to overcome* a prior art rejection.”
MPEP §1412.02.

The accompanying table illustrates the progress of examination of claim 1 in the parent patent application, which continues to be numbered as claim 1, and, ignoring *arguendo* the issue of whether or not the doctrine may be applied to support a recapture, graphically illustrates the absence in the prosecution history of “*arguments and changes* to the claims made *in an effort to overcome* a prior art rejection” that are requisite to invocation of the doctrine of recapture.

TABLE I

<u>Claim 1</u>	<u>Claim 1</u>
<u>Before 12/01/98 Amendment</u> first and second projections ... to define first and second air bearing surfaces (lines 10, 11)	<u>After 12/01/98 Amendment</u> No change of this clause. (lines 10, 11)
curved front wall portion (lines 15, 16)	arcuate front wall portion (lines 15, 16)
so as to define a rounded (line 20)	The Amendment completely deleted this limitation.
curved front wall portion and said first and second curved side wall portions being spaced apart from said first and second projections (lines 22-24)	The Amendment completely deleted this limitation.
wherein the first and second curved side wall portions respectively extend along said first and second side portions of said principal surface and define (lines 24, 25)	The Amendment completely deleted this limitation.
third and fourth air bearing surfaces located at a rear portion of said principal surface (lines 25, 26)	third and fourth air bearing surfaces (lines 25, 26)
located at said rear portion of said principal surface (line 26)	The Amendment completely deleted this limitation.
at a position central located in the lateral (line 32)	The Amendment completely deleted this limitation.

As illustrated by the table, no narrowing amendments were made to the language of the three constituent elements now cited by the Examiner as triggering a recapture. Absent narrowing amendments of any of these three constituent elements, there was no surrender in the scope of coverage.

Moreover, as illustrated by the table, claim 1 was elsewhere broadened in scope by amendment to broaden the original definition of "third and fourth air bearing surfaces located at a

rear portion of said principal surface" to add the phrase "said first and second wall portions terminating at said rear portion of said principle [sic, principal] surface of said slider body for defining" before the original phrase "third and fourth air bearing surfaces." This amendment broadened the scope of claim 1 by completely deleting any reference to the "rear portion" limitation. Claim 1 was further broadened in scope by completely deleting such limitations as "curved front wall portion and said first and second curved side wall portions being spaced apart from said first and second projections" from lines 22-24.

The Amendment of the 1st of December 1998 was filed in response to an Office Action (Paper No 4) dated on the 1st of September 1998, that made a single art rejection of claims 1 through 10 and 14 under 35 U.S.C. §102(b) "as being clearly anticipated by CHAPIN et al (5,200,868). Note the embodiment in figure 3j." *Examiner's Comments*, page 2. The Amendment of the 1st of December 1998 contained clarifying, rather than *Festo* type substantive amendments, to substitute "arcuate" for "curved" in line 15 of claim 1.

Subsequently, claims 1, 3, 7, 9 through 19 and 21 through 25 were allowed by Paper No. 8; a Notice of Allowance then issued on the 7th of December 1998.

Patented claims 1 through 15 did not recite the clause "four separate air bearing surfaces" when originally presented or when amended; these claims do not now contain that clause. That claim appears only in patented claim 16, lines 24, 25, which was added in the Amendment of the 1st of December 1998 and never rejected. Hence, even ignoring the doctrine of claim differentiation, claim 21 provides no basis for the Examiner to assert that the doctrine of recapture requires the presence of this clause in the re-issue claims, because that clause was neither added to patented

claims 1 through 15 during prosecution in an effort to avoid a prior art rejection, nor was that clause argued during prosecution as patently distinguishing patent claims 1 through 15 over the prior art. In short, that clause was not present and its wording was not an issue. The doctrine of recapture provides no basis for asserting that the clause “four separate air bearing surfaces” from patent claim 16 should be present in the reissue claims 21 through 60, because that clause was never present in all of the patented claims (*i.e.*, this aspect is absent from patent claims 1 through 15) when those claims were first rejected. Consequently, that clause was not both added to all of the patented claims and then argued “*in an effort to overcome* a prior art rejection” as is required by Office practice defined by *MPEP* §1412.02, as is established by the following analysis represented by Tables II and III:

TABLE II

<u>Claim 1</u>	<u>Claim 1</u>	<u>Claim 21</u>
<u>Before 12/01/98 Amendment</u>	<u>After 12/01/98 Amendment</u>	<u>As Finally Rejected</u>
first and second projections ... to define first and second air bearing surfaces (lines 10, 11)	No change of this clause. (lines 10, 11)	No comparable limitation.
curved front wall portion (lines 15, 16)	arcuate front wall portion (lines 15, 16)	U-shaped air-bearing platform (line 9)
so as to define a rounded (line 20)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.
curved front wall portion and said first and second curved side wall portions being spaced apart from said first and second projections (lines 22-24)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.

wherein the first and second curved side wall portions respectively extend along said first and second side portions of said principal surface and define (lines 24, 25)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.
third and fourth air bearing surfaces located at a rear portion of said principal surface (lines 25, 26)	third and fourth air bearing surfaces (lines 25, 26)	comprising not more than two separate air bearing platforms (line 9)
located at said rear portion of said principal surface (line 26)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.
at a position central located in the lateral (line 32)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.

In essence, Table II establishes that reissue claim 21 includes, albeit sometimes in other terms, all aspects of original and amended patent claim 1 except for the “first and second projections...”, and that none of the three aspects listed by the Examiner in the final rejection as being omitted from claim 21 were “surrendered” to overcome the rejection of patent claim 1.

TABLE III

<u>Claim 1</u>	<u>Claim 1</u>	<u>Claim 31</u>
<u>Before 12/01/98 Amendment</u> first and second projections ... to define first and second air bearing surfaces (lines 10, 11)	<u>After 12/01/98 Amendment</u> No change of this clause. (lines 10, 11)	<u>As Finally Rejected</u> No comparable limitation.
curved front wall portion (lines 15, 16)	arcuate front wall portion (lines 15, 16)	U-shaped air-bearing platform (line 10)

so as to define a rounded (line 20)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.
curved front wall portion and said first and second curved side wall portions being spaced apart from said first and second projections (lines 22-24)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.
wherein the first and second curved side wall portions respectively extend along said first and second side portions of said principal surface and define (lines 24, 25)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.
third and fourth air bearing surfaces located at a rear portion of said principal surface (lines 25, 26)	third and fourth air bearing surfaces (lines 25, 26)	comprising not more than two separate air bearing platforms (line 9)
located at said rear portion of said principal surface (line 26)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.
at a position central located in the lateral (line 32)	The 12/01/98 Amendment completely deleted this limitation.	No comparable limitation.

Table III establishes that reissue claim 31 includes, albeit sometimes in other terms, all aspects of original and amended patent claim 1 except for the “first and second projections...”, and that none of the three aspects now asserted by the Examiner as being omitted from claim 31 were “surrendered” to overcome the rejection of patent claim 1.

Reference to the amendments made during prosecution of the original patent in the light of the foregoing table establishes that the phrases “a curved frontwall”, and “third and fourth air bearing surfaces” were already present in the claims prior to the first Office action. All of these phrases were present in the pending claims prior to issuance of the first Office action; as is explained in greater

detail below, none of these phrases could be said to have been added to the claims by amendment in order “to overcome such prior art applied in the application which matured into the parent for which reissue is being sought”, as is required by §706.02(l)(1) of the *Manual*.

In Paper No. 15, the Advisory Action dated 5 December 2002, the Examiner stated “that the tables presented by Applicant’s attorney are misleading and misdescriptive when they state that certain limitations were cancelled without acknowledging that replacement recitations for these were added in differen [*sic*, different?] places in those claims.” The Examiner’s use of “claims” in the plural number is incorrect; only original patent claim 1 is at issue.

Second, the Examiner’s comments suggest that the deleted limitations were inserted elsewhere in the amended claim 1; this is not the case. The bulk of the deleted limitations, based upon actual word count, were deleted in their entirety. Moreover, the Examiner’s comment in Paper No. 15 misses the issue of the Examiner’s theory of the existence of a recapture estoppel. Table 1 illustrates that even ignoring *arguendo*, the absence of any doctrine of recapture estoppel, as opposed to an improper recapture of surrendered subject matter under 35 U.S.C. §251, the Examiner’s theory of recapture estoppel is ill-founded simply because the two to for aspects of claim 1 alternatively listed by the Examiner as being required to be included within any reissue claim in order to prevent recapture estoppel, were amended to more broadly define those aspects of claim 1 after entry of the amendment of 1 December 1998, even though other amendments to other aspects of claim 1 may have been made by Appellant.

Third, the Examiner’s comment also misses the overriding issue that claims 21 through 60 define subject matter different from that defined by patent claim 1. The Examiner’s attempt to gauge

allowability of reissue claims on the basis of a limitation-by-limitation comparison of the patent claim to each of the reissued claims is contrary to the procedure required by the Commissioner and improper. Under the Examiner's theory of recapture estoppel, the single definition given by the patent claim is the sole gauge of allowability of each reissued claim. A practical implementation of the Examiner's theory forces each reissue claim to be narrower than the patent claim, regardless of the express contemplation of broader reissue claims under 35 U.S.C. §251. In essence, the Examiner's theory of recapture estoppel is the "very literalism" that Justice Kennedy complained of when reversing the decision of the United States Court of Appeals for the Federal Circuit and its theory of prosecution history estoppel under the doctrine of equivalence, in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831, 1841 (2002); reviewed in *Harvard Law Review*, Vol. 116 @ 405 (2002). These tables are presented not only to show that the features and aspects in patent claim 1 asserted by the Examiner to be critical on the issue of surrender, were broadened by the amendment of 1 December 1998, as well as to show that independent reissue claims 21, 31, 42, 52 and 55 are each directed to structures that are different from those defined by patent claim 1.

Turning now from the amendments and examining the remarks made by the Appellant during the prosecution of the original patent, in the *Remarks* of Appellant's response filed on the 1st of December 1998, Appellant traversed the rejections of claims 1 through 15 for several "reason(s)", as was explained on pages 11 and 12 of that response. These reasons were given in the alternative, and any one of these reasons was separately sufficient to require a withdrawal of the rejections of claims 1 through 15:

First, in those *Remarks* Appellant explained that the Examiner's reliance upon

Chapin et al. '868 to support a rejection of claim 1 under 35 U.S.C. §102(b) was incorrect, because Chapin '868 lacked several of the features of the parent claim 1.

Second, in the *Remarks* Appellant explained that Chapin '868 relied upon by the Examiner to support the several rejection under 35 U.S.C. §102(b), lacked Appellant's "two trailing platforms 110c and 110b, [that] are connected by cross rail 130 to create a negative pressure pocket", and could not make a *prima facie* showing of anticipation. These features were already present in independent apparatus claims 1 through 15 prior to the rejection, and were not added by amendment.

Third, page 12 of those *Remarks* explained that the Examiner's rejection of these claims was incorrect by making an alternative reference to differences between side rails 20, 22 of Chapin '868 and those of the rejected claims, by explaining that Chapin '868's side rails 20, 22 "create very narrow air channels 30 and 32 running from the front to the rear of the slider.

Accordingly, Appellant's *Remarks* in the response dated on the 1st of December 1998 traversing "the rejections of claims 1 through 15 for several "reason(s)" do not constitute the joint acts of "arguments *and* changes to the claims made in an effort to overcome a prior art rejection" that are requisite to invocation of the doctrine of recapture under the mandatory procedure of *MPEP* §1412.02. The Examiner must therefore, re-examine reissue claims 21 through 60 in accordance with *MPEP* §1412.02. The *Manual* explains the "criteria for determining that subject matter has been surrendered", by stating that:

"[i]f the limitation now being omitted or broadened in the present

reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by Appellant, and impermissible recapture exists. *MPEP* §1412.02.

These criteria are not met where the claims in the original application were allowed, without substantive amendment, over the applied prior art because original patent claim 1 defined a structure not found in the applied art of Chapin '868. Appellant's very brief *Remarks* simply demonstrated numerous, alternative features of the original claims that each separately served to distinguish those patent claim 1 from the prior art. Where, as is illustrated in the discussion of Issue "E" next following, an anticipation rejection is wholly specious, an applicant must respond, and under 37 C.F.R. §1.111(c), "must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made." The fact that an applicant complies with this law does not subsequently estop the applicant from seeking broader claims under 35 U.S.C. §251 in a reissue application. In short, where the original claims are allowable over the prior art because the prior art fails to make a *prima facie* showing, the multiple act criteria required by the *Manual* are not satisfied. Appellant submits however, that in view of absence of the *Manual*'s multiple acts of a "limitation ... [that] was originally presented/argued/stated in the original application to make the claims allowable", and the demonstrated absence of the joint acts of "*arguments and changes to the claims made in an effort to overcome a prior art rejection*", no *impermissible* recapture exists under the *Manual*'s criteria; this rejection of claims 21 through 60 should not be sustained. Such action is respectfully requested.

E. Where Appellant correctly demonstrates that the prior art fails to teach what the Office action represented that art as teaching, Appellant's demonstration of those deficiencies in the prior art does not thereafter create a recapture estoppel that restricts the scope of reissue coverage to reissue claims that recite what was lacking in the prior art.

As is explained in the foregoing paragraphs, in the Amendment filed on the 1st of December 1998, Appellant correctly explained that the two, alternative primary references relied upon by the Examiner to support the rejection under 35 U.S.C. §102(b), lacked several particular structural components of independent apparatus claim 1 of anticipation. Appellant's demonstration of the numerous deficiencies in the Examiner's rejections however, does not establish the "surrender" that is an essential condition prerequisite to invocation of the doctrine of recapture. Nowhere did Appellant argue that the features missing from the Examiner's art served to patentably distinguish a patent claim over the prior art; in the Amendment filed on the 1st of December 1998, Appellant simply demonstrated that there were multiple deficiencies in the art cited by the Examiner, and that those numerous deficiencies prevented the prior art from supporting a rejection under 35 U.S.C. §102(b). The fact that Appellant separately, and alternatively noted that any of these exemplary deficiencies required withdrawal of the rejections, does not create any basis for invoking the doctrine of recapture because Appellant simply demonstrated the impropriety of the rejection.

By way of a simplified analogy, if the Examiner had cited the first U.S. Patent Grant issued by George Washington on the 31st of July 1790 to Samuel Hopkins for his *Discovery in the Making of Potash and Pearl Ash* to support a rejection of claims 2 through 7 and 9 under 35 U.S.C. §102(b), and if, in the Amendment filed on the 1st of December 1998, Appellant had explained to the Examiner that the rejection was improper because Hopkins '001 lacked either an *U-shaped*

projection...including an arcuate front wall, or third and fourth air bearing surfaces, neither 35 U.S.C. §251 nor the doctrine of recapture would thereafter require all of Appellant's reissue claims to contain either an *U-shaped projection...including an arcuate front wall, or third and fourth air bearing surfaces*. Appellant's citation of at least three distinct features, found to be lacking in the Examiner's art does not mean that there ever after, reissue claims are limited to combinations that include one or more of these elements, particularly where the prior art not only lacked these elements, but could not have used these elements in the practice of their respective intended modes of operation. The mere fact that Appellant correctly demonstrated to the Examiner, that the prior art failed to teach what the Office action represented that art as teaching, does not thereafter create a recapture estoppel that restricts the scope of reissue coverage to claims that recite what was lacking in the prior art.

Appellant's response to the ill-founded anticipation rejection was complete and in full compliance with U.S. law. Even though the rejection given in Paper No. 4 mailed on the 1st of September 1998, under 35 U.S.C. §102(b) over Chapin, *et alii*, U.S. 5,200,868 was specious, Appellant in its amendment of the 1st of December 1998 had to respond under law. Moreover, under 37 C.F.R. §1.111(c), Appellant,

“must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.” 37 C.F.R. §1.111(c).

An applicant's only alternative, abandonment of the application, is not viable. The fact that an Appellant fully complied with the law does not subsequently estop Appellant from seeking broader claims under 35 U.S.C. §251 in a reissue application.

Moreover, the fact that the phrase “four separate air bearing surfaces” was not present in patented independent apparatus claim 1, (but was present in only newly presented claim 16) which was subsequently allowed by the Examiner, further demonstrates the fallacy of the Examiner’s assertion that the reissue claims must recite certain limitations that are present in some of the patented claims, but absent from other patent claims. If patented independent claim 1 lacks this “four separate air bearing surfaces” language found in independent claim 16, the Examiner can not properly require Appellant to include these elements in any of the reissue claims.

F. Where the Office Action Fails To Make A Finding Of In What Aspects The Reissue Claims Are Broader Than The Patent Claims, and Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter, The Rejection Must Be Withdrawn.

The Examiner also asserts that:

The following limitations have been omitted from the newly presented reissue claims.”

Nothing in 35 U.S.C. §251 requires that an Appellant’s claims of enlarging scope to be “related in scope to like process/method claims in the parent” patent. Where, as here, an Appellant chooses to use different nouns and verbs to define his invention, nothing in 35 U.S.C. §251 authorizes the Examiner to maintain a rejection on the grounds now asserted by the Examiner, namely that the rejected claims are not “related in scope to like process/method claims in the parent” patent. The Examiner’s reasoning is a *non sequitur* because claims of enlarging scope, by definition, must differ in scope, and can not therefore, be “related in scope to like process/method claims in the parent”

patent. Consequently, the Examiner's reason given for refusing allowance of claims 21 through 60 is contrary to logic, unauthorized by statute, and should not be maintained upon reconsideration.

G. The Examiner's Rejection Of Claims 21-60 Under 35 U.S.C. §251 Is An Improper, Back-door Attempt To Revive The *Point-of-novelty* Criterion For Patentability.

The Examiner's assertion that claims 21 through 60 are related in scope to like apparatus claims in the parent which require the reasons stated in the prosecution history as discussed above to be present in the reissue claims, the Examiner is, in effect, improperly re-writing U.S.C. §251 to require that the reissue claims contain the same point-of-novelty language as the patented claims. This ignores the fact that the point-of-novelty test has been long discarded by the Court of Appeals, that 35 U.S.C. §251 contains no point-of-novelty criteria and that the statute, as represented by sections such as 35 U.S.C. §103(a), mandates that the Examiner must consider the subject matter claimed "as a whole", rather than as isolated limitations. Application of the point-of-novelty test ignores the fact that in the reissue, Appellant's inventions may be alternatively defined by the interaction of the combination of constituent elements, rather than by a single point-of-novelty phrase. It is therefore, unreasonable to expect, and there is no requirement under §251, that the reissue claims be slavishly patterned after the language of the patented claims.

H. Alternative Statements Made By An Appellant To Explain The Impropriety of A Rejection Under 35 U.S.C. §102 Are Not An Amendment Of The Claim And Do Not Constitute A Surrender Of Patentable Subject Matter Under 35 U.S.C. §251.

The Examiner further argues the rejection of claims 21 through 60 on grounds that:

The record of the application for the patent shows that the

broadening aspect (in the reissue) relates to subject matter that Appellant previously surrendered during prosecution of the application.

The language referred to by the Examiner is the language of the Appellant as written in the *Remarks*, rather than the language of the patent claims, and that language demonstrates in two distinct paragraphs, **five** different reasons why Chapin '868 fails to anticipate patented claim 1. Appellant has no right of appeal from a decision by the Examiner who withdraws a rejection and passes an application to issue; consequently, whatever language may be employed by an Appellant in the *Remarks*, does not create an estoppel or establish any basis for recapture, simply because the basis for the estoppel lies in the language of the claims, not in a paraphrase of the language of the claims. Where, as here, the Examiner correctly accepted Appellant's alternative reasons for traversal, there is no basis for the Examiner during the reissue prosecution, to claim that arguments presented by Appellant establish a basis for recapture where the distinguishing features were not added to the claims by amendment.

Moreover, the Examiner's assertion that the rejected claims do not include an "arcuate front wall portion" is factually incorrect because the actual language of claim 1 is "a U-shaped projection...for defining a negative pressure cavity therein" and third and fourth air bearing surfaces." These reissue claims present definitions not found in the original patent claims, and thus the reissue claims as a whole define a scope different from the original claims. More importantly, these reissue claims differ in scope from any of the claims examined by the Examiner in the patent. Thus, these reissue claims with their different scope of coverages, can not be said to recapture something that was surrendered during prosecution of the patent. Simply put, the subject matter of these reissue

claims could not have been surrendered during the original prosecution because the subject matter was never presented for examination during prosecution of the patent.

As earlier explained herein, even assuming *arguendo* the existence of some sort of bar to recapture in the instant application, the existence of that bar does not deny the Appellant the ability to broaden the scope of coverage by using *alternative language* to define his inventions. Nothing under the doctrine of recapture requires an Appellant to use the exact and precise language present in the patented claims. Furthermore, some of the patented claims, such as independent apparatus claim 16, broadly define Appellant's alternative "four separate and distinct positive pressure areas." Accordingly, there is no basis for maintaining a rejection of claims 20 through 60 on grounds that these claims lack language mentioned either Appellant's Remarks or in other independent claims.

I. Even Ignoring Arguendo A Lack Of Basis For Imposition Of A Rejection Under The Doctrine Of Recapture And A Failure Of The Examiner To Follow The Mandated Procedure Under MPEP §1412.02, Claims 21 Through 60 Each Define At Least One Of The Constituent Aspects Required By The Examiner.

Considering again the Examiner's argument that the rejection of claims 21 through 60 on grounds that:

The following limitations have been omitted from the newly presented reissue claims: "first and second projections" defining "first and second air bearing surfaces" (claims 21, 31, 42, 52, 55 and 58); "arcuate front wall portion" (claims 21, 31, as now amended 42, 52, 55, and 58), and "third and fourth air bearing surfaces" (claims 21, 52, 55, and 58).

In the amendment of 12/01/98 in the parent application Appellant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based

upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces.”

the Examiner’s attention is invited to the actual language of the rejected claims.

First, the Examiner supports this rejection by asserting that “the record of the application for the patent shows that the broadening aspect (in the reissue) relates to the subject matter that Appellant has previously surrendered during the prosecution of the application.” This is incorrect, and the Examiner has not been able to identify any surrender of any subject matter during the prosecution of the parent application. Absent surrender, there is no basis to support the **Examiner's** averment of recapture. Withdrawal of this rejection is therefore required.

Second, the Examiner cites “the following limitations [as having] been omitted from the newly presented reissue claims: 'first and second projections' defining 'first and second air bearing surfaces' (claims 21, 31 and 42); 'arcuate front wall portion' (claims 21 and 31), and 'third and fourth air bearing surfaces' (claim 21).” The Examiner's assertions are factually incorrect on the record. Evidence of this is found in the Examiner's assertion that:

“In the amendment of 12/01/98 in the parent application Appellant specifically argued (see remarks on pages 11-12) the following structural features to defined [sic] over the 102 rejection based upon CHAPIN et al. (5,200,868.): (a) an arcuate front wall”, (b) third and fourth air bearing surfaces, and c) four separate air bearing surfaces.”

This is an incorrect reading of statement of fact presented in the paragraph bridging pages 11 and 12 of Appellant's Amendment of 1 December 1998. In that Amendment, Appellant simply explained that any one of six distinct features of claim 1 each independently serve to separately and

alternatively distinguish claim 1 over Chapin '868, by explaining that:

- ① “Claims 1-3, 7, 9-19, and 21-25 are drawn to a negative pressure air bearing slider which includes “*a U-shaped projection ... including an arcuate front wall ... for defining a negative pressure cavity therein.*”
- ② The U-shaped projection also has first and second side wall portions “*for defining third and fourth air bearing surfaces.*”
- ③ Appellant respectfully submits that the claimed slider is not disclosed anywhere in Chapin. For example, Figure 3j cited by the Examiner shows a slider which clearly has
- ④ neither a U-shaped projection with an arcuate front wall portion for defining a negative pressure cavity,
- ⑤ nor does it have *third or fourth air bearing surfaces* spaced apart on the slider body.
- ⑥ Likewise, none of the numerous other embodiments shown in Chapin disclose a slider according to any of the claims 1-3, 7, 9-19, and 21-25.”

The foregoing excerpt from Appellant's 1998 Amendment clearly demonstrates that the Examiner's assertion about “four separate air bearing surfaces” is unfounded. This excerpt from Appellant's Remarks is written in the alternative; none of these features are shown by Chapin '868. In short, Appellant was, in this excerpt, simply explaining to the Examiner that *any one* of those six features in claim 1 were alone sufficient to individually, patentably distinguish claim 1 over Chapin '868 under 35 U.S.C. §102(b). Moreover, the issue is moot about the other two features, both of which are broadly contemplated by the rejected claim 21 through 51 as well as subsequently added claims 52 through 60. The Examiner's reliance upon Appellant's demonstration of the absence of a *prima facie* showing of anticipation by Chapin '868 is misplaced and is not helpful to completion of the

examination.

Third, Appellant further explained on page 11 of the 1998 Amendment, that:

“Moreover, as can be clearly seen in Fig. 3j cited by the Examiner, Chapin's air bearing slider has the side rails 20 and 22 connected from leading edge to trailing edge without any broken sections. In contrast, in the air bearing slider according to the present claimed invention there are no side rails connected from leading edge to trailing edge. Instead, as shown in Fig. 4 and recited in independent claims 1 and 21, there are the four separate air bearing surface (ABS) platforms 110a, 110b, 110c and 110d distributed at the four edges of the surface. The two trailing platforms, 110c and 110d, are connected by cross rail 130 to create a negative pressure pocket. This clearly distinguishes the slider of claims 1-3, 7, 9-19, and 21-25 of the present invention from Chapin.”

That statement illustrates, as was expressly stated, that the presence of four separate air bearing surfaces “clearly distinguishes” the claims argued over exemplary art references Chapin '868. That statement does not however, surrender any subject matter disclosed in the original application, and is directed to specific embodiments and implementations of Appellant's invention that are disclosed in the originally filed application and claimed by patent claim 16, although not by patent claim 1.

The Examiner's attention is also invited to the Appellant's demonstration, set forth on page 12 of Paper No. 6, of the complete absence of any similarity between the disclosures of Chapin '868 and the disclosure of Appellant's original specification. In a discussion contrasting Appellant's Fig. 4 with “Fig. 3j [of Chapin '868] cited by the Examiner, Appellant demonstrated a lack of anticipation. In that discussion of the drawings, Appellant wrote:

“Moreover, as can be clearly seen in Fig. 3j cited by the Examiner, Chapin's air bearing slider has the side rails 20 and 22 connected from leading edge to trailing edge without any broken sections. In

contrast, in the air bearing slider according to the present claimed invention there are no side rails connected from leading edge to trailing edge. Instead, as shown in Fig. 4 and recited in independent claims 1 and 21, there are four separate air bearing surface (ABS) platforms 110a, 110b, 110c and 110d distributed at the four edges of the surface.” Appellant’s *Remarks*, Paper No. 6, page 12.

The Examiner’s interest in this comparison of the drawings is not explained in the Office Action. In this discussion Appellant is simply examining the detail of the very drawing of Chapin ‘868 used by the Examiner to support the anticipation rejection. This discussion is simply an observation that the evidence relied upon by the Examiner to support the rejection under 35 U.S.C. §102(b) was inadequate. Moreover, in that discussion, Appellant did not refer to either “(a) an arcuate front wall” or “(b) third and fourth air bearing surfaces” as alleged by the Examiner here, but Appellant did refer to (c) four air bearing surfaces”, although, as is explained below, this was to show the existence of yet another basis that was alone sufficient to patentably distinguish claim 16 from Chapin ‘868 under 35 U.S.C. §102(b).

In the same paragraph of that discussion on page 12 of Paper No. 6, the Appellant further explained to the Examiner, by reference to the various elements illustrated in Appellant’s Fig. 4, that:

“The two trailing platforms, 110c and 110d, are connected by cross rail 130 to create a negative pressure pocket.” Appellant’s *Remarks*, Paper No. 6, page 12.

The significance of this distinction between Appellant’s Fig. 4 and Chapin’s Fig. 3j, was then emphasized by the Appellant’s subsequent statement:

“This clearly distinguishes the slider of claims 1-3, 7, 9-19, and 21-25 of the present invention from Chapin.” Appellant’s *Remarks*, Paper No. 6, page 12.

The particular language used by the Appellant, namely that “[t]he two trailing platforms, 110c and 110d, are connected by cross rail 130 to create a negative pressure pocket”, was used in the *Remarks* to explain this distinction between Appellant’s Fig. 4 and Chapin’s Fig. 3j and to thereby demonstrate that Chapin’s Fig. 3j could not possibly support an anticipation rejection of independent claim 1; the fact that other features and aspects of the patent claims also served to illustrate the error in the anticipation rejection does not create a surrender of Appellant’s right to obtain reissue claims.

Consequently, even ignoring *arguendo* the absence of an amendment creating a basis for a recapture investigation, there is therefore, no basis for a recapture rejection in Appellant’s amendment of the 1st of December 1998. Consequently, the Examiner’s reliance upon Appellant’s explanation set forth in the *Remarks* of the 1998 Amendment, about the impropriety of the rejection under 35 U.S.C. §102(b), is improper, inaccurate and misplaced. This rejection should not be sustained.

Fourth, as rejected under 35 U.S.C. §102(b) over Chapin ‘868 in Office Action No. 5, claim 1 **originally** recited “first and second projections ... to define first and second air bearing surfaces” That is, the phrases quoted by the Examiner were present in claim 1 prior to the rejection under §102(b). This provides no basis for asserting recapture.

Fifth, as rejected under 35 U.S.C. §102(b) over Chapin ‘868 in Office Action No. 6, claim 1 **originally** recited “a curved front wall portion” This clause was broadened by amendment, to read “arcuate front wall portion” The Examiner’s assertion that “arcuate” was added by amendment is misleading; “arcuate” was substituted for “curved.” The broadening of a claim can not serve as the foundation for a recapture rejection, because the broadening does not surrender any

of Appellant's scope of coverage. Absent surrender, there is no recapture. To the contrary, the broadening enlarges the scope of coverage.

Sixth, as rejected under 35 U.S.C. §102(b) over Chapin '868 in Office Action No. 6, claim 1 **originally** recited "third and fourth air bearing surfaces" This feature was not added by amendment; consequently, there is no basis for asserting a recapture of a feature added to the claims in order to overcome the rejection under 35 U.S.C. §102(b) as anticipated by Chapin '868 because this feature was already present in claim 1 prior to the rejection. The Examiner's assertion in paragraph 7, that "Appellant clearly amended the originally filed claims to add ... "third and fourth air bearing surfaces" is factually incorrect. Accordingly, a rejection premised upon incorrect statements of fact, must not be sustained.

II. Rejection of Claims 21 through 41 Under Second Paragraph of 35 U.S.C. §112

In paragraph 3 of the Office action, the Examiner newly rejected claims 21 through 41 as being allegedly indefinite under the second paragraph of 35 U.S.C. §112. Appellant traverses this rejection for the following reasons.

A. Where The Applicant Defines Five (5) Structural Features Of Claim 21 By Defining The Location Relative To The Orientation Of The Air Bearing Slider Claimed, A Rejection Under The First Paragraph of 35 U.S.C. §112 For Failure to recite any reference to the locations of the listed features Is Improper.

The Examiner explained this rejection as justified because claim 21 "fails to recite any reference for the locations of the *listed* features." The Examiner fails to give any explanation for this statement. The Examiner's comment infers that claim 21 is an aggregation, but the following review

of claim 21 shows the interrelation of the constituent structural elements of claim 21.

A careful reading of claim 21 establishes the presence of references for the locations of all of the constituent elements of claim 21:

“a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion and a rear portion, said lead portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body”, and

“said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body... .”

Dissection of this language confirms the presence of references for the locations of each of these constituent elements relative to “a recording surface of a recording medium”:

Principal surface:	disposed to confront a recording surface of a recording medium.
Said principal surface:	having a lead portion and a rear portion.
Said lead portion:	being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider.
Said lead portion:	having a front edge.
Said rear portion:	having a rear edge.
Said front edge and said rear edge <i>together</i> :	defining boundaries of said principal surface in a <i>longitudinal direction</i> of said slider body.

In summary, the *principal surface*, the *lead portion* and *rear portion* are located by reference respectively to the *recording surface* of a recording medium and the relative directions of upstream from one another, *relative to a rotational direction* of any recording medium confronted by said slider. Moreover, the *lead portion* is defined as having a *front edge* while the *rear portion* is defined as having a *rear edge*, and the *front edge* and *rear edge together* are said to define “boundaries of said principal surface in a *longitudinal direction* of said slider body.”

Each and every one of the constituent elements defined by claim 21, are related by reference to location for both the slider body and any recording medium confronted by the slider body.

The Examiner’s comments state that “the patented claims referenced the features to the rotational direction of the medium confronted by the slider.” The appropriateness of this comment is not apparent because claim 21 already expressly reads:

“principal surface disposed to confront a recording surface of a *recording medium*”;

“said principal surface having a lead portion and a rear portion, said lead portion being spaced upstream from said rear portion relative to a *rotational direction* of any *recording medium* confronted by said slider”; and

“at least one of said first rear termination and said second rear termination not coinciding with said rear edge, and being disposed upstream of said rear edge relative to said *rotational direction* of said *recording medium*.”

The recording medium and its rotational direction is simply a workpiece, and not a constituent element of the claim. Referencing constituent elements to a workpiece or to a characteristic of a workpiece is only one way to define the subject matter which an applicant may regards as his

invention. The use of this technique is not mandatory under 35 U.S.C. §112 because there are other acceptable claim drafting techniques. The fact is that the evidence of record establishes that Appellant did use this technique in drafting claim 21. Consequently, the record may not be read as supporting the final Office action's averment that "claim 21, as now amended, fails to recite any reference for the locations of the listed features." There is therefore, no evidence of record that justifies maintenance of this rejection.

The Examiner singled-out independent claims 21 and 31 in this rejection, and did not explain whether the comment that claim 21 "fails to recite any reference for the locations of the *listed* features" was also applicable to the only other independent claim rejected, claim 31. The Examiner's comment infers that claim 31 is an aggregation, but the following review of claim 31 shows the interrelation of the constituent structural elements of claim 31.

In explaining the rejection of claim 31, the Examiner states that claim 31 "fails to recite a reference for the 'first direction.'" The Examiner also noted that the "patented claims" referenced features to the rotational direction confronted by the slider. Claim 31 already recites,

"a principal surface defining a first plane tangential to a first direction, said principal surface having a lead portion and a rear portion, said lead portion being spaced upstream from said rear portion relative to said first direction, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said first direction."

Careful examination of the excerpted language of claim 31 establishes that each of the constituent elements defined within the text of claim 31 are defined as having locations and those locations are related to the "principal surface" and, in the subsequent text of claim 31, the "U-shaped airbearing

platform” is related to both the “principal surface” and to the “first direction”:

A principal surface:	defining a first plane tangential to a <i>first direction</i> .
Principal surface:	having a lead portion and a rear portion.
Said lead portion:	being spaced upstream from said rear portion relative to said first direction.
Said lead portion:	having a front edge.
Said rear portion:	having a rear edge.
Said front edge and said rear edge <i>together</i> :	defining longitudinal boundaries of said principal surface in said first direction.

Each and every one of the constituent elements defined by claim 31, are related by reference to location for both the slider body and any recording medium confronted by the slider body. There is therefore, no basis for maintaining this rejection.

B. Is A Rejection Under The Second Paragraph of 35 U.S.C. §112 On Grounds That Claim 31 fails to recite a reference for ‘the first direction’ Improper Where The Applicant Uses The “first direction” To Establish Structural Relationships Between Three (3) Constituent Elements Of Claim 31?

The Examiner also asserts that “claim 31 fails to recite a reference for the first direction.”

Claim 31 defines Appellant’s air bearing slider in terms of:

“a principal surface defining a first plane tangential to a *first direction*;
said principal surface having a lead portion and a rear portion,
said lead portion being spaced upstream from said rear portion relative to said *first direction*, said lead portion having a front edge,
said rear portion having a rear edge, said front edge and said rear edge

together defining longitudinal boundaries of said principal surface in said *first direction*... .”

Claim 31 is written with the *first direction* relating Appellant’s principal surface, lead portion an rear portion, and the front edge, rear edge and longitudinal boundaries to one another. Although many sins of indefiniteness are possible under the second paragraph of 35 U.S.C. §112 (although today, not as many as formerly), the use of a *first direction* to tie several constituent structural features of an article together has never been impermissible under any of these rules of indefiniteness. The appropriateness of Appellant’s use of a *first direction* to relate several constituent structural features is further evidenced by the complete absence of any averment in the final Office action of any of the numerous possible types of indefiniteness recognized under the second paragraph of 35 U.S.C. §112. There is no evidence on the record before the Board which would justify sustaining this rejection.

The Examiner’s comments state that “the patented claims referenced the features to the rotational direction of the medium confronted by the slider.” The recording medium and its rotational direction is simply a workpiece, and not a constituent element of the claim. Referencing constituent elements to a workpiece or to a characteristic of a workpiece is only one way to define the subject matter which an applicant may regards as his invention. The use of this technique is not mandatory under 35 U.S.C. §112 because there are other acceptable claim drafting techniques. Appellant did not use this technique in drafting claim 31, but referenced the constituent structural elements with the other claim drafting techniques explained in the foregoing paragraphs. Consequently, the record may not be read as supporting the final Office action’s averment that “claim 31, as now amended, fails to recite any reference for the locations of the listed features.”

There is therefore, no evidence of record that supports the maintenance of this rejection.

III. Rejection of Claims 21 - 60 Under First & Second Paragraphs of 35 U.S.C. §112

In paragraph 4 of the Office action, the Examiner again rejected claims 21 through 51 under the first and second paragraphs of 35 U.S.C. §112, based upon the Examiner's averment, repeated verbatim from Paper No. 6, that "the claimed invention is not described in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same, and/or for filing to particularly pointing out and distinctly claim the subject matter which Appellant regards as the invention." Appellant respectfully traversed this rejection for the following reasons.

A. Where The Rejected Claims Define An Embodiment Of The Appellant's Invention As Disclosed In Appellant's Original Patent, There Is No Basis For Maintaining A Rejection Under The First Paragraph Of 35 U.S.C. §112 For Failure To Provide Either A Written Description Of The Invention Or For Failure To Provide Enablement.

First, while the Examiner's characterization of Appellant's invention is extremely broad, the rationale given by the Examiner to support this rejection fails to satisfy the statute. The Examiner argues that,

"the claimed invention is not described in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same, and/or for filing to particularly pointing out and distinctly claim the subject matter which applicant regards as the invention."

Under 35 U.S.C. §112, the Congress gave exclusive and sole authorization to the inventor, not to the Examiner, to determine "the subject matter which the Appellant regards as his invention." See the

second paragraph of 35 U.S.C. §112. While the Examiner's thoughts about the novelty disclosed by Appellant in the specification are appreciated, it is Appellant alone, rather than the Examiner, who has been authorized by the Congress of the United States, to determine the subject matter of his invention. The fact that Appellant seeks broad coverage for his invention by defining combinations of different salient features, has nothing to do with enablement, if those features have been properly disclosed. Both the *OG* figure, and other figures, such as Figures 9 and 10, clearly show structures defined by the newly presented claims, including newly presented claims 52, 55 and 58, with a "U-shaped air bearing platform defining a negative pressure cavity on said principal surface." The fact that particular implementations of Appellant's inventions as defined by claims 21 through 60 may require additional structure such as an armature, a voice coil motor, a transducer and a sealed container, or even a source of electrical power in order to be operable, are irrelevant to determinations of novelty. Novelty is determined by the scope of the art relative to the prior art. Consequently, the breadth of Appellant's pending claims provides no basis for rejecting these claims under either the second or the first paragraph of §112; accordingly, this rejection is improper, has no authority under the statute and should not be sustained.

Second, the Examiner argues that the original disclosure:

"showed only slider configurations with two separate front air bearing surfaces and a [*sic*, an] U-shaped cross rail with a side extension on each side terminating near the rear edge with an air bearing surface. There is NO disclosure of a slider having: (a) a cross rail without the two separate front air bearing surfaces, (b) a cross rail with only one side extension, (c) only a total of one air bearing surface between the two side extensions, or (d) the side extensions having different lengths, with only one terminating before the trailing end of the slider."

These four averments bear consideration in light of the detailed description provided by Appellant's patent.

The *Detailed Description* of the specification of Appellant's patent describes an air bearing slider illustrated, by way of example, in Figs. 4 and 5. Reissue claims define Applicant's negative pressure slider for a hard disk driver with trailing air bearing surface platforms 110c and 110d symmetrically disposed on opposite sides on a longitudinal axis of the slider body 100 and aligned with one another in a lateral direction of the slider body 100, to provide a positive lifting force at the air outlet between the slider body 100 and the disc surface. As is explained in the *Detailed Description* of applicant's patent,

“ these trailing ABS platforms 110c and 110d ... provide a positive lifting force at an air outlet between the slider body and the disc surface (not shown).” Column 5, lines 27-33.

This level of detail and explanation of the concomitant advantages attributable to this structure defined by independent claims 21 (which defines “a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface ...”), 31 (which defines “a U-shaped air bearing platform having a plurality of air bearing surfaces surrounding a negative pressure cavity”), 42 (which defines “a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms ...”), 52 (which defines “a plurality of arcuately shaped arms ... with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform ... to separately define a negative pressure cavity defined

by said arms ..." and 58 (which defines "a plurality of arcuately shaped arms ... curving inwardly ... together forming a U-shaped air bearing platform ... to separate a negative pressure cavity defined by said arms ..."), illustrates the fidelity between independent reissue claims 21, 31, 42, 52 and 55, and the *Detailed Description* provided by the patent. This fidelity is evidence of record of not only both the existence and completeness of the written description and the enablement provided by the specification, but also as presentation in these claims of language that particularly points out and distinctly claims the subject matter which Appellant regards as his invention, that negatives the Examiner's rationale that:

"the claimed invention is not described in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same, and/or for filing to particularly pointing out and distinctly claim the subject matter which applicant regards as the invention."

An arcuate cross rail 130 extends across the principal surface 111 of the slider 100 between air bearing surface platforms 110c, 110d. As is explained in the original specification,

"[t]he arcuate cross rail 130 and the rear ABS platforms 110c and 110d together define a substantially U-shaped projection that extends from the principal surface 111 of the slider 110. The curvature of the cross rail 130 forms a negative pressure cavity 150, that may be somewhat rounded at the center of the slider body 110." Column 5, lines 41-46.

Column 6, lines 4 through 7 explain that this negative pressure cavity 150 functions to provide a downward pulling action on the slider body 100, which in turn creates a gram load equivalent effect that advantageously enhances stability.

Column 6, lines 19-22 identifies another advantage of the arcuate configuration of the cross rail 130 resides in the fact that contaminants will have less of tendency to accumulate against the front wall of the cross rail. That is, contaminants will instead tend to travel along the arcuate front wall and exit off the side of the slider body between the gaps formed by the front corner ABS projections. Column 6, lines 25 and 26 states that this also enhances read/write performance of the slider 100 over the long-run.

The reissue claims accurately and faithfully conform, albeit with differing definitions of Appellant's inventions, to these excerpts from the specification. By way of example, rejected claim 21 defines *inter alia*,

“a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface”

Claim 31 defines,

“a U-shaped air bearing platform having a plurality of air bearing surfaces surrounding a negative pressure cavity”,

while claim 42 defines,

“a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms ...”,

claim 52 defines,

“a plurality of arcuately shaped arms ... with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform ... to separately define a negative pressure cavity defined by said arms ...”

and claim 58 defines,

“a plurality of arcuately shaped arms ... curving inwardly ... together forming a U-shaped air bearing platform ... to separate a negative pressure cavity defined by said arms”

These are all structures that conform to the description provided by the *Detailed Description* of the patent, which teaches that:

“ these trailing ABS platforms 110c and 110d ... provide a positive lifting force at an air outlet between the slider body and the disc surface (not shown)”, column 5, lines 27 through 33,

and that:

“[t]he arcuate cross rail 130 and the rear ABS platforms 110c and 110d together define a substantially U-shaped projection that extends from the principal surface 111 of the slider 110. The curvature of the cross rail 130 forms a negative pressure cavity 150, that may be somewhat rounded at the center of the slider body 110.” Column 5, lines 41 through 46.

Nowhere in either claims 21, 31, 42, 52 or 55, nor in any of the other rejected claims, does the word “without” appear, as is suggested by the Examiner’s rationale. In view of the conformity of the reissue claim to the patent’s specification, questions of enablement, written description and indefiniteness are immaterial to the patentability of claims 21 through 60.

Moreover, absent the words “only”, “the side extensions having different lengths”, “with only one”, or “with only one terminating before the trailing end of the slider” asserted by the Examiner in the itemization (A) through (d) in support of this rejection, there is no basis for maintaining this rejection.

The Examiner seems to be surreptitiously challenging the scope and breath of reissue claims

21 through 60. A challenge of their breadth and scope is the office of 35 U.S.C. §§102 and 103, rather than 35 U.S.C. §112. The rejection of all of the reissue claims 21 through 60 under both the first and the second paragraphs of 35 U.S.C. §112 may not be sustained where there is no evidence of record to establish that the reissue claims do not define the *subject matter* which the Appellant regards as his invention.

**B. Where No Error Or Other Instance Of Inaccuracy Or Indefiniteness Is Averred,
A Rejection Under The Second Paragraph Of 35 U.S.C. §112 Is Improper.**

The Final Office action makes no allegation that Appellant's claims 21 through 60 either incorrectly, inaccurately or indefinitely defined the subject matter which Appellant has asserted that he regards as his invention. Moreover, nothing in the second paragraph of 35 U.S.C. §112 authorizes the Examiner to substitute the judgment of the Examiner for that of the Appellant, and thus contradict the Appellant in the Appellant's determination of that subject matter. Furthermore, there is neither any factual averment given in support of this rejection which Appellant may address nor evidence of record justifying the maintenance of this rejection under the second paragraph of 35 U.S.C. §112. This style of examination unfairly denies Appellant an opportunity to expeditiously advance the prosecution. Absence averment and evidence on the record, this rejection of reissue claims 21 through 60 under both the first and the second paragraphs of 35 U.S.C. §112 may not be sustained.

IV. Rejection Of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela '981

A. Where The Applied Art Fails To Disclose All Of The Elements Of The Rejected Claims, There Is No Anticipation Under 35 U.S.C. §102(a).

In paragraph 6 of the Office action, the Examiner rejected claims 21, 30-32, and 41 under 35 U.S.C. §102 for alleged anticipation by Nepela *et al.* U.S. Patent No. 5,568,981. Appellant respectfully traversed this rejection for the following reasons.

The final Office action asserts anticipation by Nepela '981. Inherency is not alleged. Although the Examiner asserts that Figs. 4b, 4c, 5b, 5c and 5d of Nepela '981 show "a slider with an U-shaped platform with a negative pressure cavity (not numbered) behind a cross rail 98 ", Figs. 4b, 4c, 5b, 5c and 5d in these drawings of Nepela '981 uniformly illustrate three discrete elements, namely side rails 72, 74 and cross rail 98 forming what the Examiner alleges to be a *U-shaped platform*. These drawings fail to show either Appellant's "U-shaped air bearing platform defining the negative pressure cavity" or "said U-shaped air bearing platform comprising not more than two separate air bearing platforms ...", or Appellant's "U-shaped air bearing platform defining the negative pressure cavity" with "said U-shaped air bearing platform comprising not more than two separate air bearing platforms ...", as defined by claims 21, 31, 52, 55 and 58, any one of which constituent element serves to patentably distinguish the rejected claims over Nepela '981.

Moreover, and as a separate demonstration of patentable novelty under 37 C.F.R. §1.111(c), Figs. 4b, 4c, 5b, 5c and 5d of Nepela '981 also uniformly illustrate three discrete and separate, spaced-apart central front pad (*e.g.*, 84) and side rails (*e.g.*, 72, 74). All three of these elements must be used in an effort to meet Applicant's U-shaped air bearing platform of claims 21 and 31. Elimination of central front pad 84 from Nepela '981 would impermissibly destroy its structure and

defeat its expressed mode of operation. With just side rails 72, 74, Nepela '891 defines neither a U-shape nor a negative pressure cavity. In short, Nepela '891 not only lacks Appellant's "U-shaped air bearing platform defining a negative pressure cavity ..." with "said U-shaped air bearing platform comprising not more than two separate air bearing platforms" defined by claim 21, and lacks Appellant's "U-shaped air bearing platform having a plurality of air bearing surfaces surrounding a negative pressure cavity ..." with "said U-shaped air bearing platform comprising not more than two separate air bearing platforms ..." defined by claim 31. Without central front pad 84, relatively strait and elongated side rails 72, 74 not only do not form a negative pressure cavity, but they do not provide claim 31's surrounding of a negative pressure cavity. Under the *all-elements* rule of an interpretation of 35 U.S.C. §102(a), if *any element* of rejected claim is missing from the applied art, there can be no anticipation. Consequently, Nepela'981 fails to anticipate any of these claims. Accordingly, this rejection may not be maintained under the *all elements* rule of 35 U.S.C. §102(b).

IX. CONCLUSION

Absent an amendment narrowing some aspect of a patented claim during prosecution of the patent, Appellant's good faith compliance the rule of law codified by 37 C.F.R. §1.111, and particularly with 37 C.F.R. §1.111(c) by demonstrating in Appellant's *Remarks* the patentable novelty which the claims present and the absence of anticipation under 35 U.S.C. §102(b), precipitates no "surrender" of the scope of some aspect of coverage to which an applicant is entitled under such exemplary decisions as *In re Gaff*, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997) or *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984). The fact that the first Office action during

prosecution of Appellant's patent was improper under 35 U.S.C. §102 in view of the numerous deficiencies in the Chapin '868 patent cited, does not indelibly create either a recapture estoppel or a surrender under the recapture doctrine that forever after requires the Appellant to include those patentably distinguishing aspects of patent claim 1 in each and every reissue claim. The Board is respectfully requested to refuse to sustain this recapture rejection under 35 U.S.C. §251 of claims 21 through 60.

Turning now to the rejection of claims 21 through 41 under the second paragraph of 35 U.S.C. §112, neither claim 21 or 31 are an aggregation; both independent claims 21 and 31 already define five structural features of the air slider bearing in terms of their location relative to the orientation of the air slider bearing. Appellant's use of a *first direction* to relate several constituent structural elements is accepted claim drafting practice. There is no basis on the record before the Board which would justify sustaining this rejection.

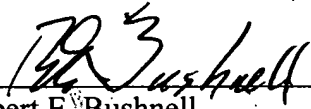
The rejection of all of the reissue claims 21 through 60 under both the first and the second paragraphs of 35 U.S.C. §112 may not be sustained where there is no evidence of record to establish that the reissue claims do not define the *subject matter* which the Appellant regards as his invention.

The sole art rejection of claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) as anticipated by Nepela '981 may not be sustained because Nepela '981 fails to disclose all of the elements defined by the rejected claims. No claim limitation may be ignored in making a patentability analysis. *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ 2d 1031 (Fed. Cir. 1994) ("The PTO must consider all claim limitations when determining the patentability of an invention over the prior art.") Consequently, the anticipation under 35 U.S.C. §102(a) may not be sustained.

This brief is filed in triplicate, together with the fee of \$320.00 incurred under 37 C.F.R.

§1.17(c).

Respectfully submitted,


Robert E. Bushnell,
Attorney for the Appellant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040
Folio: P56525RE
Date: 12/9/2
I.D.: REB/wc

X. APPENDIX

CLAIMS ON APPEAL (21-60)

1 21. (Amended) A negative pressure air bearing slider having a negative pressure cavity,

2 comprising:

3 a body with a principal surface disposed to confront a recording surface of a recording
4 medium, said principal surface having a lead portion and a rear portion, said lead portion being
5 spaced upstream from said rear portion relative to a rotational direction of any recording medium
6 confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge,
7 said front edge and said rear edge together defining boundaries of said principal surface in a
8 longitudinal direction of said slider body; and

9 a U-shaped air bearing platform defining a negative pressure cavity on said principal surface,
10 said U-shaped air bearing platform comprising not more than two separate air bearing platforms each
11 extending rearwardly toward said rear portion of said principal surface and respectively terminating
12 at a first rear termination and a second rear termination, at least one of said not more than two
13 separate air bearing platforms including a side wall portion;

14 at least one of said first rear termination and said second rear termination not coinciding with
15 said rear edge, and being disposed upstream of said rear edge relative to said rotational direction of
16 said recording medium.

1 22. The negative pressure air bearing slider according to claim 21, further comprising:

2 a gap disposed within said cross rail portion.

1 23. The negative pressure air bearing slider according to claim 22, wherein:

2 said gap is centered with respect to a longitudinal axis of said slider body.

1 24. The negative pressure air bearing slider according to claim 22, wherein:

2 said gap is off-centered with respect to a longitudinal axis of said slider body.

1 25. The negative pressure air bearing slider according to claim 21, further comprising:

2 a recessed step disposed within said cross rail portion.

1 26. The negative pressure air bearing slider according to claim 25, wherein:

2 said recessed step is centered with respect to a longitudinal axis of said slider body.

1 27. The negative pressure air bearing slider according to claim 25, wherein:

2 said recessed step is off-centered with respect to a longitudinal axis of said slider body.

1 28. The negative pressure air bearing slider according to claim 21, further comprising:

2 a first front air bearing platform; and

3 a second front air bearing platform;

4 said first and said second front air bearing platforms being disposed on opposite sides of said
5 principal surface symmetrically about a longitudinal axis of said slider body, said first and second

6 front air bearing platforms being disposed upstream of said U-shaped air bearing platform relative
7 to a rotational direction of said recording medium.

1 29. The negative pressure air bearing slider according to claim 28, wherein:
2 a tapered surface portion is interposed between said front edge and each of said first and said
3 second front air bearing platforms, the tapered surface portion tapering from each air bearing surface
4 toward said front edge of said slider body.

1 30. The negative pressure air bearing slider according to claim 21, further comprising:
2 a rear air bearing platform accommodating mounting of a transducer, said rear air bearing
3 platform being spaced downstream of said U-shaped air bearing platform relative to a rotational
4 direction of said recording medium, and being centered with respect to a longitudinal axis of said
5 slider body.

1 31. (Amended) A negative pressure air bearing slider, comprising:
2 a principal surface defining a first plane tangential to a first direction;
3 said principal surface having a lead portion and a rear portion, said lead portion being spaced
4 upstream from said rear portion relative to said first direction, said lead portion having a front edge,
5 said rear portion having a rear edge, said front edge and said rear edge together defining longitudinal
6 boundaries of said principal surface in said first direction; and
7 a U-shaped air bearing platform having a plurality of air bearing surfaces surrounding a

8 negative pressure cavity while defining a second plane tangential to said first direction, said U-
9 shaped air bearing platform comprising not more than two separate air bearing platforms each
10 extending from said lead portion rearwardly toward said rear portion and respectively terminating
11 at a first rear termination and a second rear termination, at least one of said not more than two
12 separate air bearing platforms including a side wall portion;

13 at least one of a surface between said first rear termination and said rear edge and a surface
14 between said second rear termination and said rear edge being in said first plane.

1 32. The negative pressure air bearing slider according to claim 31, wherein said U-shaped
2 air bearing platform further comprising:

3 a cross rail portion extending generally laterally across said principal surface.

1 33. The negative pressure air bearing slider according to claim 32, further comprising:
2 a gap disposed within said cross rail portion.

1 34. The negative pressure air bearing slider according to claim 33, wherein:
2 said gap is centered with respect to a longitudinal axis of said slider body.

1 35. The negative pressure air bearing slider according to claim 33, wherein:
2 said gap is off-centered with respect to a longitudinal axis of said slider body.

1 36. The negative pressure air bearing slider according to claim 32, further comprising:
2 a recessed step disposed within said cross rail portion.

1 37. The negative pressure air bearing slider according to claim 36, wherein:
2 said recessed step is centered with respect to a longitudinal axis of said slider body.

1 38. The negative pressure air bearing slider according to claim 36, wherein:
2 said recessed step is off-centered with respect to a longitudinal axis of said slider body.

1 39. The negative pressure air bearing slider according to claim 31, further comprising:
2 a first front air bearing platform; and
3 a second front air bearing platform;
4 said first and said second front air bearing platforms being disposed on opposite ends of said
5 principal surface symmetrically about a longitudinal axis of said slider body, said first and second
6 front air bearing platforms being disposed upstream of said U-shaped air bearing platform relative
7 to said direction of flight of said slider.

1 40. The negative pressure air bearing slider according to claim 39, wherein:
2 a tapered surface portion is interposed between said front edge and each of said first and said
3 second front air bearing platforms, the tapered surface portion tapering from each air bearing surface
4 toward said front edge of said slider body.

1 41. (Amended) The negative pressure air bearing slider according to claim 31, further
2 comprising:

3 a rear air bearing platform accommodating mounting of a transducer, said rear air bearing
4 platform being spaced downstream of said U-shaped air bearing platform relative to said first
5 direction, and being centered with respect to a longitudinal axis of said slider body.

1 42 (Amended) A negative pressure air bearing slider, comprising:

2 a slider having a body with a principal surface disposed to confront a recording surface of
3 a recording medium, said principal surface having a lead portion and a rear portion, said lead portion
4 being spaced upstream from said rear portion relative to a rotational direction of any recording
5 medium confronted by said slider with a longitudinal axis of said slider extending between said lead
6 portion and said rear portion defining a longitudinal direction of said slider and forming a tangent
7 to said rotational direction, said lead portion having a front edge, said rear portion having a rear edge,
8 said front edge and said rear edge together defining boundaries of said principal surface in said
9 longitudinal direction of said slider; and

10 a U-shaped air bearing platform defining a negative pressure cavity on said principal surface,
11 said U-shaped air bearing platform comprising not more than two separate air bearing platforms each
12 extending from different and facing spaced-apart opposite ends of said not more than two separate
13 air bearing platforms rearwardly toward said rear portion of said principal surface and respectively
14 forming a first air bearing surface terminating said first side wall portion and forming a second air

15 bearing surface terminating said second side wall portion, at least one of said not more than two
16 separate air bearing platforms including a side wall portion with said U-shaped platform comprising
17 an arcuately shaped front wall oriented toward said lead portion.

1 43. The negative pressure air bearing slider according to claim 42, further comprising a gap
2 disposed within said cross rail portion.

1 44. The negative pressure air bearing slider according to claim 43, wherein said gap is
2 centered with respect to said longitudinal axis of said slider body.

1 45. The negative pressure air bearing slider according to claim 43, wherein said gap is off-
2 centered with respect to said longitudinal axis.

1 46. The negative pressure air bearing slider according to claim 42, further comprising a
2 recessed step disposed within said cross rail portion.

1 47. The negative pressure air bearing slider according to claim 46, wherein said recessed step
2 is centered with respect to said longitudinal axis.

1 48. The negative pressure air bearing slider according to claim 46, wherein said recessed step
2 is off-centered with respect to said longitudinal axis.

1 49. The negative pressure air bearing slider according to claim 42, further comprising:
2 a first front air bearing platform; and
3 a second front air bearing platform;
4 said first and said second front air bearing platforms being disposed on opposite sides of said
5 principal surface symmetrically about said longitudinal axis of said slider body, said first and second
6 front air bearing platforms being disposed upstream of said U-shaped air bearing platform relative
7 to said rotational direction.

1 50. The negative pressure air bearing slider according to claim 49, further comprised of:
2 a tapered surface portion is interposed between said front edge and each of said first and said
3 second front air bearing platforms, the tapered surface portion tapering from each air bearing surface
4 toward said front edge of said slider body.

1 51. The negative pressure air bearing slider according to claim 42, further comprising a rear
2 air bearing platform accommodating mounting of a transducer, said rear air bearing platform being
3 spaced downstream of said U-shaped air bearing platform relative to a rotational direction of said
4 recording medium, and being centered with respect to said longitudinal axis of said slider body.

1 52. A negative pressure air bearing slider having a negative pressure cavity comprising:
2 a body with a principal surface disposed to confront a recording surface of a recording

3 medium, said principal surface having a lead portion separated from a rear portion by a central
4 portion, said lead portion and said central portion being spaced upstream from said rear portion
5 relative to a rotational direction of any recording medium confronted by said slider, said lead portion
6 having a front edge, said rear portion having a rear edge, said front edge and said rear edge together
7 defining boundaries of longitudinal sides of said principal surface in a longitudinal direction of said
8 slider body; and

9 a plurality of arcuately shaped arms each having distal ends extending from opposite ones
10 of said longitudinal sides curving inwardly across said central portion of said principal surface with
11 spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform
12 located between said boundaries to separate a negative pressure cavity defined by said arms on said
13 principal surface from said boundaries;

14 a distal end of at least one of said arms forming a terminal end wholly within said central
15 portion and spaced-apart from said rear portion.

1 53. The negative pressure air bearing slider of claim 52, further comprising a cross-rail
2 portion of said platform extending generally laterally across said principal surface and connecting
3 said proximal facing ends.

1 54. The negative pressure air bearing slider of claim 52, further comprising said arms
2 adjoining said boundaries.

1 55. A negative pressure air bearing slider having a negative pressure cavity comprising:

2 a body with a principal surface disposed to confront a recording surface of a recording
3 medium, said principal surface having a lead portion separated from a rear portion by a central
4 portion, said lead portion and said central portion being spaced upstream from said rear portion
5 relative to a rotational direction of any recording medium confronted by said slider, said lead portion
6 having a front edge, said rear portion having a rear edge, said front edge and said rear edge together
7 defining boundaries of longitudinal sides of said principal surface in a longitudinal direction of said
8 slider body; and

9 a plurality of arcuately shaped arms each having distal ends extending from opposite ones
10 of said longitudinal sides arcuately inwardly across said principal surface with spaced-apart proximal
11 facing ends of said arms together forming a U-shaped air bearing platform located between said
12 boundaries to separate a negative pressure cavity defined by said arms on said principal surface from
13 said boundaries;

14 a distal end of at least one of said arms forming a terminal end wholly within said central
15 portion and spaced-apart from said rear portion.

1 56. The negative pressure air bearing slider of claim 55, further comprising a cross-rail
2 portion of said platform extending generally laterally across said principal surface and connecting
3 said proximal facing ends.

1 57. The negative pressure air bearing slider of claim 55, further comprising said arms

bordering said longitudinal sides.

58. A negative pressure air bearing slider having a negative pressure cavity comprising:

a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion separated from a rear portion by a central portion, said lead portion and said central portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of longitudinal edges of said principal surface in a longitudinal direction of said slider body, said central portion being formed by opposite longitudinal sides separated by a longitudinal center and bounded by said longitudinal edges; and

a plurality of arcuately shaped arms each having distal ends extending from opposite ones of said longitudinal sides curving inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries;

at least one of said distal ends forming a terminal end wholly within said central portion and spaced-apart from said rear portion.

59. The negative pressure air bearing slider of claim 58, further comprising a cross-rail portion of said platform extending generally laterally across said principal surface and connecting

3 said proximal facing ends.

1 60. The negative pressure air bearing slider of claim 58, further comprising said arms
2 adjoining said longitudinal edges.